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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/735,379	12/12/2000	Robert V. Epley	36968-166670	4591

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EXAMINER

CANGIALOSI, SALVATORE A

ART UNIT	PAPER NUMBER
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2661

DATE MAILED: 04/02/2004 10

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/735,379

Applicant(s)

EPLEY, ROBERT V.

Examiner

Salvatore Cangialosi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6,8-19,21-30 and 32-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6,8-19,21-30 and 32-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152). |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>4</u> . | 6) <input type="checkbox"/> Other: _____ |

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d887, 225 USPQ645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d937, 214 USPQ761 (CCPA 1982); *In re Vogel*, 422 F.2d438, 164 USPQ619 (CCPA 1970); and, *In re Thorington*, 418 F.2d528, 163 USPQ644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR1.321 may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR3.73(b).

2. Claims 1-6, 8-19, 21-30, 32-38 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3 of prior U.S. Patent No. 6,603,764. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are included within the scope of the claims of the prior patent.

Regarding claim 1, which corresponds to elements of claim 1 of the patent, the claimed elements a-e and g are identical to elements a-e and g of the claim while element f is an obvious implementation of method claim 1 of the patent. Claims 2-4 are obvious equivalents to patent claim 1's forwarding information because they are obvious routing data of the claimed method. Claim 5 is an obvious equivalent to the alert that the message has reached the narrowest region of element f of patent claim 1. The hierarchical limitation of claim 6 is an obvious equivalent to the database of patent claim 1. The scoped code limitation of claim 8 is an obvious equivalent to the scoped code of element a of patent claim 1 and a virtual connection is an obvious form of device connection. The table limitation of claim 9 is an obvious equivalent to the database of patent claim 1. The ATM limitation of claim 10 is an obvious equivalent to the disclosed transport of patent claim 1. The ATM format limitation of claim 11 is an obvious equivalent to the disclosed transport format of patent claim 1. The database limitations of claims 12-13 are obvious equivalents to the databases access of patent claim 1. The platform limitation of claim 14 is an obvious equivalent to the database access of patent claim 1. The digital limitation of

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claim 15 is an obvious equivalent to the data of patent claim 1. Regarding claim 16, which corresponds to elements of claim 2 of the patent, the claimed elements second device, plurality of switches and database are identical to the same elements of the claim while first device and wherein clause are obvious abbreviated forms of the same elements of claim 2 of the patent. Claims 17-19 are obvious equivalents to patent claim 2's forwarding information because they are obvious routing data of the claimed system. The digital limitation of claim 21 is an obvious equivalent to the data of patent claim 2. The switch limitation of claim 22 is an obvious equivalent to the at least one switch of patent claim 2. The database limitation of claim 23 is an obvious equivalent to the database of patent claim 2. The message limitation of claim 24 is an obvious equivalent to the message of patent claim 2. The setup limitation of claim 25 is an obvious equivalent to the alert of patent claim 2. The connect message limitation of claim 26 is an obvious equivalent to the alerted message of patent claim 2. The virtual connection of claim 27 is an obvious form of device connection of claim 2. The digital limitation of claim 28 is an obvious equivalent to the data of patent claim 2. Regarding claim 29, which corresponds to elements of claim 3 of the patent, the claimed elements second network, switches and database are identical to the same elements of the claim while first network and third switch clause are obvious abbreviated forms of the same elements of claim 3 of the patent. The fourth switch limitation of claim 30 is an obvious equivalent to the fourth switch of patent claim 3. The scoped code limitation of claim 32 is an obvious equivalent to the scoped code of patent claim 3. The ATM limitation of claim 33 is an obvious equivalent to the disclosed transport of patent claim 3. The ATM format limitation of claim 34 is an obvious equivalent to the disclosed transport format of patent claim 3. . Regarding claim 35, which corresponds to elements of claim 2 of the patent, the claimed two part address are identical to the same elements of the claim. Regarding claim 36, which corresponds to elements of claim 2 of the patent, the claimed elements devices, two part address are identical to the same elements of the claim. Regarding claim 37, which corresponds to elements of claim 1 of the patent, the claimed two part address are identical to the same elements of the claim. Regarding claim 38, which corresponds to elements of claim 1 of the patent, the claimed two part address are identical to the same elements of the claim. It would have been obvious to the person having ordinary skill in this art to provide a similar arrangement for the Epley patent because it is included within the claimed scope of the invention.

3. Claims 29,30, 32-34 are rejected under 35 U.S.C. . 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The independent claim (e.g. capable of) recite intended uses or capabilities which are not positive limitations(See In Re Collier, 156 USPQ 266)

4. The following is a quotation of 35 U.S.C. . 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

5. Claims 35-38 are rejected under 35 U.S.C. . 103 as being unpatentable over Lipsit et al or Henry Jr. et al.

Regarding claim 35, Lipsit et al(See Figs. 1-3, Col. 1, lines 30-35) or Henry Jr. et al(See Fig. 3) disclose a wireless telecommunication device having a multi-part address. One portion of the address including a customer id(machine id) and another portion supplied by a service provider within a particular geographic location. The differences between the above and the claimed invention is the recognition that the service provider portion of the wireless identifier is itself a geographic identifier. Any wireless system would meet this criteria employ a home location register. Either Lipsit et al or Henry Jr. et al would therefore obviously have a service provider geographic component identifier. It would have been obvious to the person having ordinary skill in this art to provide a similar arrangement

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for Lipsit et al or Henry Jr. et al because it is a fair reading of existing structure. Regarding claim 36, Lipsit et al (See Figs. 1-3, Col. 1, lines 30-35) or Henry Jr. et al (See Fig. 3) disclose a wireless telecommunication device having a multi-part address. One portion of the address including a customer id(machine id) and another portion supplied by a service provider within a particular geographic location. The differences between the above and the claimed invention is the recognition that the service provider portion of the wireless identifier is itself a geographic identifier. Any wireless system would meet this criteria employ a home location register. Either Lipsit et al or Henry Jr. et al would therefore obviously have a service provider geographic component identifier. It would have been obvious to the person having ordinary skill in this art to provide a similar arrangement for Lipsit et al or Henry Jr. et al because it is a fair reading of existing structure. Regarding claim 37, , Lipsit et al (See Figs. 1-3, Col. 1, lines 30-35) or Henry Jr. et al (See Fig. 3) disclose a wireless telecommunication device having a multi-part address. One portion of the address including a customer id(machine id) and another portion supplied by a service provider within a particular geographic location. The differences between the above and the claimed invention is the recognition that the service provider portion of the wireless identifier is itself a geographic identifier. Any wireless system would meet this criteria employ a home location register. Either Lipsit et al or Henry Jr. et al would therefore obviously have a service provider geographic component identifier. It would have been obvious to the person having ordinary skill in this art to provide a similar arrangement for Lipsit et al or Henry Jr. et al because it is a fair reading of existing structure. Regarding claim 38, , Lipsit et al (See Figs. 1-3, Col. 1, lines 30-35) or Henry Jr. et al (See Fig. 3) disclose a wireless telecommunication device having a multi-part address. One portion of the address including a customer id(machine id) and another portion supplied by a service provider within a particular geographic location. The differences between the above and the claimed invention is the recognition that the service provider portion of the wireless identifier is itself a geographic identifier. Any wireless system would meet this criteria employ a home location register. Either Lipsit et al or Henry Jr. et al would therefore obviously have a service provider geographic component identifier. It would have been obvious to the person having ordinary skill in this art to provide a similar arrangement for Lipsit et al or Henry Jr. et al because it is a fair reading of existing structure.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Salvatore

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Cangialosi whose telephone number is (703) 305-1837. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Douglas Olms, can be reached at (703) 305-4703.

Any response to this action should be mailed to:


Commissioner of Patent and Trademarks

Washington, D.C. 20231

or faxed to (703) 872-9314 (for Technology Center 2600 only)

Hand delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, Virginia, Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.


SALVATORE CANGIALOSI
PRIMARY EXAMINER
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